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Docket No. A-3-4

REMARKS

Re. The Office Action

Claims 54-66 are pending in the Application. Of the pending claims, Claims 54-56 and 65-66 have been rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 4,116,198 ("Roos"); and, Claims 57-58 and 60-64 have been rejected under 35 U.S.C. § 103 over Roos in view of Great Britain Patent No. 2,037,167 ("Herczog"). Further, all claims have been rejected under the doctrine of non-statutory obviousness-type double patenting over U.S. Patent No. 5,697,909. The Office Action also requested that the Applicants correct and/or update text in the specification where appropriate.

Re. Information Disclosure Statement

The Applicants respectfully request consideration of the Information Disclosure Statement filed February 4, 2005.

Re. The Specification

The Applicants respectfully request an amendment to page 1 of the specification to update of the status of cross-referenced applications, as set forth herein.

Re. The Rejection of Claims under 35 U.S.C. §102(b)

The Office Action rejected Claims 54-56 and 65-66 under 35 U.S.C. § 102(b) as being anticipated by Roos. In rejecting the claims, the Office Action stated that the Applicants' arguments filed on 01/14/2005 were not persuasive because at least a portion of the Roos electrode (12) is well within the definition of a hemisphere, which according to the Examiner discloses the Applicant's claimed active electrode surface comprising a hemisphere geometry (emphasis added). In support of this rejection, the Examiner cited Merriam-Webster's Online Dictionary definition of a hemisphere as "Hemisphere: half of a spherical or roughly spherical body".

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For the following additional reasons, the Applicants respectfully disagree, and courteously request reconsideration, withdrawal of the rejection, and allowance of the Application.

As set forth in independent Claim 54, the Applicants' claimed instrument includes an active electrode surface comprising a hemispherical geometry (emphasis added). In this regard, and as the Examiner has noted, a hemisphere is half of a sphere. Thus, since it is commonly known that a sphere is any round body having a surface equally distant from the center to all points, e.g. a ball (see Collins' New World Dictionary), therefore an electrode having a hemispherical geometry is an electrode having a shape like half of a sphere i.e., half of a ball, and thus such an electrode would have an outer curved surface defined by a three-dimensional coordinate system, as opposed to an alternative planar electrode system wherein any point on the electrode surface would be defined by a two-dimensional planar coordinate system (ignoring the thickness of the electrode).

Thus, unlike the Applicant's claimed hemispherical geometry electrode, Roos' electrode is not hemispherical but is planar because Roos teaches that: (i) its electrode is a loop configured so that the operator's field of vision is uninterrupted (see Col. 2, lines 51-52); (ii) the loop is a cutting loop (see, for example, in Col 2, line 30; and Col 5, line 64), and (iii) the loop is substantially flat as is clearly depicted in Fig. 1 and in Fig. 8, a depiction which one ordinarily skilled in the art would not reasonable equate to be a hemispherical geometry.

In this regard it is particularly noted that since Roos's loop electrode is configured such that the operator's field of vision is uninterrupted, Roos's electrode cannot have a hemispherical geometry that could interrupt the field of vision.

Thus, the Applicant's claimed electrode which comprises a hemispherical geometry, is not taught or suggested by Roos; on the contrary the Applicant's electrode it is a teaching that is contrary to Roos because in one orientation the hemispherical geometry of the Applicants'

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electrode may restrict the operator's line of vision, unlike an cutting loop which is open at least in the middle.

Accordingly, since all the pending claims including independent Claims 54 and 65 require a hemispherical geometry shape electrode, all the claims are patentably distinct over Roos. Based on the foregoing the Applicants therefore respectfully request reconsideration and withdrawal of this rejection of the claims.

Re. The Rejections under 35 U.S.C. §103 (a)

The Office Action also rejected Claims 57-58 and 60-64 under 35 U.S.C. §103(a) as being unpatentable over Roos in view of Herczog et al., (GB 2037167). For the following reasons, the Applicants respectfully disagree and courteously request reconsideration, withdrawal of this rejection and allowance of the Application.

As discussed above Roos fails to disclose the hemispherical geometry of the electrode. Herczog likewise fails to disclose this limitation in the Applicants' claims as Herczog discloses a blade or two-dimensional cutting device, which is not a surface comprising a hemispherical geometry. Consequently, since no combination of the cited references teach or suggest the Applicant's claimed instrument, the *prima facie* case of obviousness under Section 103 (a) is not met. (see, for example, the MPEP § 2142). Accordingly, the Applicants respectfully request reconsideration and withdrawal of the rejections of the claims on this grounds.

Re. The Double Patenting Rejection

The Applicants will file a timely terminal disclaimer upon indication that the claims are otherwise allowable.

CONCLUSION

In view of the amendment to the specification at page 1, and the remarks herein, the pending claims are patentable and are in condition for allowance. Accordingly, reconsideration

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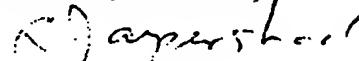
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and allowance of the Application is respectfully requested. If an issue remains that can be resolved by telephone, kindly contact the undersigned at (408) 735-6486.

Respectfully submitted,


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